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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/147,362	03/12/1999	DENIS MARIE BERNARD CHENEBAUX	P63163USO	1607

7590 06/03/2003  
JACOBSON PRICE HOLMAN & STERN  
400 SEVENTH STREET NW  
WASHINGTON, DC 20004

EXAMINER

PARKIN, JEFFREY S

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/147,362

Examiner

Jeffrey S. Parkin, Ph.D.

Applicant(s)

CHENEBAUX ET AL.

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2003.
- 2a) ☐ This action is **FINAL**.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 44-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 44-54 is/are rejected.
- 7) ☒ Claim(s) 47 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

**Detailed Office Action**

**37 C.F.R. § 1.114**

1. A request for continued examination under 37 C.F.R. § 1.114, including the fee set forth in 37 C.F.R. § 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 C.F.R. § 1.114, and the fee set forth in 37 C.F.R. § 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 C.F.R. § 1.114. Applicant's submission filed on 10 December, 2002, has been entered.

**Status of the Claims**

2. Claims 31-43 were canceled without prejudice or disclaimer and new claims 44-54 submitted. Claims 44-54 are pending in the instant application.

**37 C.F.R. § 1.75(c)**

3. Claim 47 is objected to under 37 C.F.R. § 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. The claim simply references a composition comprising at least one peptide according to claim 44. Claim 44 already contains at least one peptide, thus, it is not readily manifest how the claim language is further limiting. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claims in proper dependent form, or rewrite the claim(s) in independent form. The claims do not refer back in the alternative only, or refer to a preceding claim, or reference two sets of claims with different features, or reference another multiple dependent claim. Refer to M.P.E.P. § 608.01(n).

37 C.F.R. § 1.75

4. Applicants are advised that claims 51/52 and 53/54 appear to be substantial duplicates. As set forth *supra*, claim 47 fails to provide any further distinguishing characteristics vis-a-vis the peptidic structure. Accordingly, both sets of claims appear to employ the same composition. Applicants are advised that should claims 51 or 53 be found allowable, claims 52 and 54 will be objected to under 37 C.F.R. § 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See M.P.E.P. § 706.03(k).

35 U.S.C. § 112, Second Paragraph

5. Claims 44-54 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 44, the reference to peptides of the "monomer type" is confusing since there is no indication whatsoever that the claimed peptides normally form dimeric structures. Appropriate correction to clearly set forth the salient structural characteristics of the claimed peptides is required (i.e., A composition comprising isolated and purified linear or cyclized synthetic peptides having the following chemical structure (I):  $\Delta$ -Z-Trp-Gly-Cys- $\Theta$ -Cys-Tyr-Thr-Ser- $\Omega$  (I), wherein ..., Z is a peptide sequence having the sequence selected from the group consisting of Leu-Leu-Ser-Ser (SEQ ID NO.: 21), ...,  $\Theta$  is a peptide sequence having the sequence selected from the group consisting of Arg-Gly-Arg-Leu-Ile (SEQ ID NO.: 15), ..., and  $\Omega$  is attached to the -CO- group of Ser and is selected from the group consisting of one of the following compounds: a hydroxyl group, the

peptidyl sequence Val-Ψ, and the peptidyl sequences Val-Arg-Trp-Asn-Glu-Thr-Ψ, ...).

5 6. Claims 53 and 54 are vague and indefinite for failing to clearly set forth the salient characteristics of the kit. For instance, a diagnostic kit often comprises **vials or containers** containing the peptide of interest, suitable reagents for performing the reaction of interest (e.g., buffers and assay reagents), and directions to perform the assay of interest. However, the simple recitation of  
10 a kit simply comprising a peptide is insufficient. Is the peptide in any type of container? Are there any additional reagents present to perform a diagnostic assay? Appropriate correction is required (i.e., A diagnostic kit for the detection of HIV-1 type O-specific antibodies comprising the following: 1) a container  
15 comprising a synthetic peptide according to claim 1; 2) a container comprising a labeled antibody for the detection of peptide-antibody complexes; 3) a container comprising a buffer to remove unbound antibody; etc.).

#### Allowable Subject Matter

20 7. The claimed synthetic peptides appear to be free of the prior art and would be allowable with proper amendment to the claim language as suggested in the preceding paragraphs.

#### Correspondence

25 8. Correspondence related to this application may be submitted to Group 1600 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Official communications should be  
30 directed toward one of the following Group 1600 fax numbers: (703) 308-4242 or (703) 305-3014. Informal communications may be submitted directly to the Examiner through the following fax number: (703) 308-4426. Applicants are encouraged to notify the Examiner prior to the submission of such documents to facilitate  
35 their expeditious processing and entry.

9. Any inquiry concerning this communication should be directed to  
Jeffrey S. Parkin, Ph.D., whose telephone number is (703) 308-2227.  
The examiner can normally be reached Monday through Thursday from  
8:30 AM to 6:00 PM. A message may be left on the examiner's voice  
mail service. If attempts to reach the examiner are unsuccessful,  
the examiner's supervisors, James Housel or Laurie Scheiner, can be  
reached at (703) 308-4027 or (703) 308-1122, respectively. Any  
inquiry of a general nature or relating to the status of this  
application should be directed to the Group 1600 receptionist whose  
telephone number is (703) 308-0196.

Respectfully,

Jeffrey S. Parkin, Ph.D.  
Patent Examiner  
Art Unit 1648

31 May, 2003